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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/927,328

08/13/2001

Chicara Kawamura

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4689

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/927,328	Applicant(s) KAWAMURA ET AL.
	Examiner Katarzyna Wyrozebski Lee	Art Unit 1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 5) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1003</u> | 6) <input type="checkbox"/> Other: _____ |

In view of the applicant's response filed on 10/20/2003 following final office action was necessitated. Properly filed terminal disclaimer overcame double patenting rejection over US Application 10/107437. Rejections over the prior art of record are not overcome and are hereby incorporated here by reference.

Examiner acknowledges filing of declaration, which renders prior art of OGURI not applicable as a prior art.

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-8 rejected under 35 U.S.C. 102(b) as being anticipated by FISHER (US 5,552,478).

The discussion of the disclosure of the prior art of FISHER from paragraph 4 of the office action mailed on 06/20/2003 is incorporated here by reference.

3. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by YASUMURA (US 6,353,036).

The discussion of the disclosure of the prior art of YASUMURA from paragraph 5 of the office action mailed on 06/20/2003 is incorporated here by reference.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over FISHER (US 5,552,478) or YASUMURA (US 6,353,036) either one of which in view of SALZMAN (US 5,726,277).

The discussion of the disclosure of the prior art of FISHER or YASUMURA either one of which in view of SALZMAN from paragraph 9 of the office action mailed on 6/20/2003 is incorporated here by reference.

In the response filed on 10/20/2003 the applicants argued that none of the disclosures of the prior art teach the concurrent reaction of first depolymerizing polyester and then concurrently reacting it with polyhydric alcohol and polybasic acid component.

With respect to the above argument, the present claim recite "...by concurrently reacting polyester whose chief starting material is terephthalic acid and which has been recovered from waste material. The term "has been" signifies that the terephthalic acid was recovered from the

waste component before hand. This is what the prior art of record discloses. The polyester in the prior art of, for example, FISHER was first recovered then reacted with polyhydric alcohol and polybasic acid. In view of the above, if the process of regenerating and polymerizing is concurrent the claims should reflect that.

The applicants further argued on page 2 of the response that in the comparative example the time it takes to complete the process is longer than that of the present invention.

With respect to the above difference, the comparative example of the present invention is not reflective of the prior art of FISHER. In the prior art of record the reaction times shorter, as the acid value of the regenerated PET is obtained within 4 hours. To digested PET adipic acid was added to repolymerize it. Although the times to produce the recycled PET of the prior art of FISHER are longer, this limitation is not part of the independent claims and therefore does not overcome the prior art of FISHER (Example 1 and 2).

In the prior art of YASUMURA as the depolymerization step takes 3 hours, whereas the polymerization step. Upon reaching temperature of 140°C the addition step began and was carried for 4 hours. Next the polycondensation reaction lasted about 6 hours. The reaction times in YASUMURA are also longer than those of the present invention however, just as in the above argument, the limitation that is not part of the claim does not disqualify the prior art as a reference.

Upon receipt of this office action the examiner would like to request an interview in order to clarify the issue of "concurrent reaction" as this limitation in view of applicant's arguments as compared to the pending claims has become unclear.

The final argument that the applicants presented is that the prior art of SALSMAN does not disclose the concurrent reaction as required by the present invention.

With respect to the above argument, it is examiner's position that "concurrent reaction" the applicant refers to does need a little bit of discussion in view of the present claims and their interpretation by the examiner. The applicants did address the prior art of SALSMAN, however not the argument addressed by the examiner. The examiner stated in the last office action that the prior art of SALSMAN is utilized to provide for the use of recycled PET in paint compositions. The applicant did not discuss why it would not have been obvious to utilize the recycled PET of FISHER or YASUMURA in the disclosure of SALSMAN.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

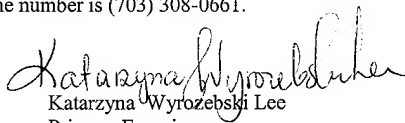
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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Katarzyna Wyrozebski Lee
Primary Examiner
Art Unit 1714

January 5, 2004